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09/924,195	08/08/2001	Shuichi Naito	M2173-1	1077
7278	7590	06/23/2005	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			TSAI, SHENG JEN	
			ART UNIT	PAPER NUMBER
			2186	

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/924,195

Applicant(s)

NAITO, SHUICHI

Examiner

Sheng-Jen Tsai

Art Unit

2186

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is taken in response to Applicant's Amendment filed on June 3, 2005 regarding application 09/924,195 filed on August 8, 2001.

2. Claims 1-20 are pending in the application under consideration.

Original claims 1-2, 6-9, 11, 14, 16, 18 and 20 have been amended.

Original claim 5 has been cancelled.

3. ***Response to Remarks and Amendment***

Applicant's amendments and remarks have been fully and carefully considered with the results detailed below.

**As to the remark:**

Applicant contend that the prior art (Komori, US 6,490,663) does not teach or suggest a "delay portion (time)." While the examiner agrees that Komori does not explicitly mention a "delay time" in the invention, the concept and practice of a "time-out" measurement is well-known and widely adopted in the art (refer to Microsoft Computer dictionary, 5<sup>th</sup> edition, 2002, Microsoft Press, page 520 – **time out** or **timeout** or **time-out**). Basically, a predetermined period of time (i.e. a delay time) is allocated in expectation of the occurrence of certain events; if the event does not take place within the specified delay window, a timeout is declared and the processor moves forward to perform other activities.

In fact, one of the prior art cited and relied upon in the previous Office Action (Funakoshi et al., EP 0903271 A2) specifically teach using the counted time value of a so-called "free run timer" (figure 2, 37; paragraph 0041) that is counted until the ignition

switch is changed over to "off" after this switch was made "on" as one of the vehicle control data to determine the level of security (Funakoshi et al., paragraph 0028).

Further, Applicant admits in the Background section of the application that the "delay portion (time)" is part of the ISO15031-7 (SAEJ2186) Standard which specifies the elapse time from IG power ON (also referred to as the "delay time") is 10 seconds or more [paragraphs 0009 and 0015-0016 of the application]. Since the feature of the "delay time" is a requirement of an existing standard, it lacks the patentability.

Applicant also contends that figure 4 of Komori does not disclose whether or not a command is inputted and what command is inputted. However, figure 1 of Komori shows the block diagram of the apparatus and the system, including a memory rewriting device (30) that communicates with the circuit (11) via a communication unit (18). It is clear that commands originate from the memory rewriting device. It is understood that details of an invention that are considered inherent are usually not specifically described. In fact, examining Applicant's claim language for all claims (1-20) reveals that not a single word of "command" is recited.

**As to the amendments:**

Claims 1-2, 6-9, 11, 14, 16, 18 and 20 have been amended with additional limitations detailing the steps of operation. These steps are previously presented in claim 5, which was rejected in the previous Office Action and has been cancelled by Applicant. Since claim 5 was rejected before, as were the other claims that are now including the limitations from claim 5, the combined and amended claims do not present

any new limitations, the same reasons of rejections based on the same prior art would apply.

Therefore, the examiner's position regarding these claims, and those claims depending from them, remain the same as stated in the previous Office Action.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, and 6-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komori (U.S. 6,490,663), and further in view of Funakoshi et al. (European Patent Application EP 0 903 271 A2).

As to claim 1 Komori teaches **an electronic control apparatus** [Komori, Electronic Control Apparatus having Rewritable Nonvolatile memory (title); Funakoshi et al., Security Device for Vehicle (title)], **comprising:**  
**a storage portion** [Komori, figure 3 shows the block diagram of storage portion, including a boot program storage area, a check program storage area, and an application program storage area; Funakoshi et al., an engine control processing unit (figure 1, 10) equipped with memories (ROM, RAM) for storing programs necessary for execution of the calculation process and control input and output data (paragraph 0039)];

**a memory portion in said storage portion** [Komori, figure 3 shows flash ROM in the storage portion; Funakoshi et al., an engine control processing unit (figure 1, 10) equipped with memories (ROM, RAM) for storing programs necessary for execution of the calculation process and control input and output data (paragraph 0039)];

**a security flag portion in said storage portion** [Komori, the head address of the check program storage area effectively serves as a security flag in the following way: The head address of the check program storage area 132a is fixed, so that the check program stored in the check program storage area 132a may be accessed accurately from the boot program stored in the boot program storage area 131 (column 4, lines 34-38); it is determined at step S201 whether the head address, where the check program is stored, is not FFh and the check program itself for determining the presence/absence of the application program is present. Here, FFh (hexadecimal notation) means that all the 8 bits (1 byte) are 1 and corresponds to 255 (decimal notation). The presence/absence of the program can be determined by whether the head address of the program is FFh, because the cell content is generally FFh and the head address of the program does not become FFh, when the flash ROM 13 is in the erased condition (column 4, lines 52-62); Funakoshi et al., the security rel instructing blk (figure 1, 18) authenticates the KEY and instructs the release of the security by the ECU 1 (paragraph 0046)];

**said memory portion being in at least one of an initial state and a written state** [Komori, figure 6 shows the case where the application program (i.e. one of the memory portion) is either present (i.e., in the written state), or is not present (i.e., in the

initial state); Funakoshi et al., the lock-out processing portion (figure 1, 11) is provided with a memory (EEPROM) to indicate a state of lock-out of the vehicle (paragraph 0047));

**said written state existing on a successful writing to said memory portion**

[Komori, figure 6 shows the case where the application program (i.e. one of the memory portion) may be present (i.e., in the written state); Funakoshi et al., the lock-out processing portion (figure 1, 11) is provided with a memory (EEPROM) to indicate a state of lock-out of the vehicle (paragraph 0047)];

**said initial state existing on at least one of an unsuccessful writing to said**

**memory portion and an unwritten state of said memory portion** [Komori, figure 6

shows the case where the application program (i.e. one of the memory portion) may not be present (i.e., in the initial state and has not been written yet)]; said security flag portion indicating a status of said memory portion as being in said at least one state

[The presence/absence of the program can be determined by whether the head address of the program is FFh, because the cell content is generally FFh and the head address of the program does not become FFh, when the flash ROM 13 is in the erased condition (column 4, lines 57-62)];

**an electronic control portion for controlling communication with said storage**

**portion** [Komori, figure 1 shows the control portion (item 11) comprising a CPU) and

the communication unit (item 18) which is under the control of the CPU and

communicates with the storage portion (item 13); Funakoshi et al., the XMTG BLK and

RECEIVING BLK of figure 1 allows ECU 1 and KEY UNIT 2 to communicate with each other];

**said electronic control portion including means for controlling, on a basis of said status, one of a writing and a rewriting to said memory portion according to an external standard having a delay portion** [Komori, figure 4 shows the case where, based on the status of step S201 (if check program address != FFh) or the status of step \$203 (if application program present), to wait for command from the memory rewriting device; Funakoshi et al., figure 1 shows the control portion allowing the external KEY UNIT 2 to write the KEY into the ECU 1; figure 2, 37 shows the free running timer that measures the duration of ignition "on" time];

**said electronic control portion further including means for bypassing said delay portion when said security flag portion indicates said status as being in said initial state, whereby said control portion avoids said delay portion** [Komori, figure 4 shows that if the flag (i.e. check program address) is FFh (i.e. in the initial state), then the rest of the operations (steps \$202 to \$204) is bypassed].

**said means for controlling comprises:**

**a first means for setting a process flag in said storage portion representing said at least one states** [Komori, the head address of the check program storage area effectively serves as a security flag in the following way: The head address of the check program storage area 132a is fixed, so that the check program stored in the check program storage area 132a may be accessed accurately from the boot program stored in the boot program storage area 131 (column 4, lines 34-38); it is determined at



step S201 whether the head address, where the check program is stored, is not FFh and the check program itself for determining the presence/absence of the application program is present. Here, FFh (hexadecimal notation) means that all the 8 bits (1 byte) are 1 and corresponds to 255 (decimal notation). The presence/absence of the program can be determined by whether the head address of the program is FFh, because the cell content is generally FFh and the head address of the program does not become FFh, when the flash ROM 13 is in the erased condition (column 4, lines 52-62); Funakoshi et al., the lock-out processing unit indicates if the security of the vehicle is in a lock-out state];

**a second means for causing said electronic control portion to start measuring a delay time** [refer to "As to the remarks"];

**a third means for causing said data rewrite portion to request a seed data from said electronic control portion** [Komori does not teach the use of seed data to calculate a security password as part of the write/rewrite operations. However, Funakoshi et al. disclose in their invention "Security Device for Vehicle" an apparatus and a method of a security device for vehicle that is of a type generating a seed that is used suitably in order to generate a key by being encoded (abstract). Figure 1 shows the block diagram of system and the seed generating block (item 13), automatic key generating block (item 15) of the control portion as well as the external unit. Figures 3 and 4 show the program flow of the authentication process, including the exchanging of the seed and the key between the control portion and the external unit.

Authentication based on generated seed and key improves the security of the vehicle

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data. Therefore, it would have been obvious for one of ordinary skills in the art at the time of Applicant's invention to realize the benefit of authentication scheme as demonstrated by Funakoshi et al., and to incorporate it into the apparatus disclosed by Komori to improve the security of the data of a vehicle];

**a fourth means for causing said electronic control portion to return said seed portion to said data rewrite portion** [Figures 1, 3 and 4 of Funakoshi et al. show the program flow of the authentication process, including the exchanging of the seed and the key between the control portion and the external unit];

**a fifth means for causing said data rewrite portion to calculate a security password based upon said seed and transmit said security password to said electronic control portion** [Figure 1 of Funakoshi et al. shows the block diagram of system and the seed generating block (item 13), automatic key generating block (item 15) of the control portion as well as the external unit];

**a sixth means for causing said electronic control portion to review said process flag** [Komori teaches that the presence/absence of the program can be determined by whether the head address of the program is FFh, because the cell content is generally FFh and the head address of the program does not become FFh, when the flash ROM 13 is in the erased condition (column 4, lines 52-62)];

**said first means requiring said electronic control portion to collate said security password when said process flag indicates said written state** [Komori teaches that the presence/absence of the program can be determined by whether the head address of the program is FFh, because the cell content is generally FFh and the head address

of the program does not become FFh, when the flash ROM 13 is in the erased condition (column 4, lines 52-62); Funakoshi et al., the correspondence deciding block (figure 1, 17) determines if the KEY match (paragraph 0046));

**said second means for requiring said electronic control portion to require said predetermined delay time when said process flag indicates said written state** [Funakoshi et al. teach using a counted time value as data for managing the level of security (paragraph 0028)];

**means for writing to said storage portion** [Komori, figure 1, abstract];

**means for determining whether said writing is complete** [figure 6 of Komori shows the case where the application program (i.e. one of the memory portion) is either present (i.e., in the written state), or is not present (i.e., in the initial state)]; **and**

**means for updating said process flag upon said complete writing into said storage portion, whereby said process flag represents said other of said state** [figure 6 of Komori shows the case where the application program (i.e. one of the memory portion) is either present (i.e., in the written state), or is not present (i.e., in the initial state)].

With respect to claim 1, Komori's invention does not mention a **delay portion** that is to be bypassed or executed, depending on the status of a certain flag. However, Funakoshi et al. specifically teach using the counted time value of a so-called "free run timer" (figure 2, 37; paragraph 0041) that is counted until the ignition switch is changed over to "off" after this switch was made "on" as one of the vehicle control data to determine the level of security (Funakoshi et al., paragraph 0028). Therefore, it would

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have been obvious for one of ordinary skills in the art at the time of Applicant's invention to realize the delay portion (i.e. time-out) is a common and widely used practice in the art to control the schedule of events, hence lacking patentability (refer to "As to Remarks.")

As to claim 2, Komori teaches **an electronic control system** [Electronic Control Apparatus having Rewritable Nonvolatile memory (title)], **comprising:**

**an electronic control portion** [ figure 1, item 11 is the corresponding control portion];

**a storage portion in said electronic control portion** [ figure 1, item 13 is the storage portion];

**said storage portion effective for storing operational data** [figure 3 shows that the storage portion includes boot program, check program, and application, all relate to operation];

**said storage portion being in one of at least an unwritten state and a written state** [refer to "As to claim 1"];

**first means for setting said written state as a first status existing upon a successful writing to said storage portion** [the head address of the check program is set to a value different from FFh to indicate the presence of the check program (column 4, lines 33-46)];

**second means for setting said unwritten state as a second status existing upon at least one of an unsuccessful writing to said storage portion and an initial storage portion** [the presence/absence of the application program may be determined

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by whether the predetermined address is a predetermined data, a check sum coincides with a predetermined value or the like (column 5, lines 50-60));

**means for writing and rewriting to said storage portion according to a security standard requiring at least a delay time before permitting said writing to said storage portion** [figure 1, item 30 shows the memory rewriting device for writing or rewriting the storage portion];

**and security bypass means in said electronic control system for identifying said at least one state and allowing said means for writing and rewriting to bypass said delay time where said unwritten state exists, whereby said means for writing and rewriting can write to said storage portion without said delay time** [refer to "As to claim 1"].

For the rest of the amended limitations of claim 2, refer to the corresponding section of "As to claim 1."

As to claim 3, Komori teaches **a security flag in said storage portion and said means for writing and rewriting effective to indicate said at least one state** [the corresponding security flag is the head address of the check program. Its value is either FFh (indicating one state) or any value different from FFh (indicating the other state).

Refer to "As to claim 1"];

**a first control portion in said electronic control portion** [figure 1, item 11 shows the first control portion];

**a first communication section in said electronic control portion** [figure 1, item 18 shows the first communication portion];

**and said first control portion effective to read said operational data from said storage portion and control said electronic control portion** [figures 2, 4, 5, 6 show the programs and operations executed by the CPU of the first control portion].

As to claim 4, figure 1, item 30 shows the memory rewriting device which hosts the second control portion and the second communication portion. Although figure 1 does not explicitly show the inside structure of the memory rewriting device, it is to be understood that without the second control and communication portion of its own, the memory rewriting device will not be able to communicate with the CPU of the storage portion. [Further, the ECU 10 includes a communication circuit 18 for executing data communications with a memory rewriting device 30, which is connected when an internal combustion engine control program and data within the microcomputer 11 are to be rewritten (column 3, lines 35-40)].

As to claim 6, refer to "As to claim 1" and "As to claim 2."

As to claim 7, refer to "As to claim 1" and "As to claim 2."

As to claim 8, refer to "As to claim 1" and "As to claim 2." Further, figure 2, step \$101 shows the controller performs initial setting to initiate a power on state. Moreover, figures 2, 4, 5, and 6 illustrate the sequence of operations being performed during the initial/rewriting operations.

As to claim 9, refer to "As to claim 1" and "As to claim 2."

As to claim 10, refer to "As to claim 1" and "As to claim 2."

As to claim 11, refer to "As to claim 1" and "As to claim 2."

As to claims 12-13, refer to "As to claim 1" and "As to claim 2." Further, Komori also teaches that in the conventional determination of the presence and absence of an application program, the presence/absence of the application program is determined by providing 00h as the specific data at the specified address of the application program, for instance at the last of the application program, and by reading the data in that address by the boot program and determining whether it is 00h. Here, h of 00h denotes the hexadecimal number (in hexadecimal notation), and 00h (hexadecimal notation) indicates 0 (decimal notation) in which all 8 bits (1 byte) are 0 (column 1, lines 51-60). Thus, it is also adapted to be utilized as a flag to indicate the status of storage portion.

As to claim 14, refer to "As to claim 1" and "As to claim 2."

As to claim 15, refer to "As to claims 12-13."

As to claim 16, refer to "As to claim 1" and "As to claim 2." Further, the apparatus disclosed by Komori is associated with a vehicle, as figure 1, item 20 shows an engine. [In FIG. 1, numeral 10 designates an internal combustion engine electronic control apparatus (ECU) (column 3, lines 19-20)].

As to claim 17, refer to "As to claim 15."

As to claim 18, refer to "As to claim 1" and "As to claim 2." Further, figures 2, 4, 5, and 6 illustrate the program flow of operations being performed during the initial/rewriting operations.

As to claim 19, refer to "As to claim 15."

As to claim 20, refer to "As to claim 1" and "As to claim 2." Further, Komori also teaches that in the conventional determination of the presence and absence of an application program, the presence/absence of the application program is determined by providing 00h as the specific data at the specified address of the application program, for instance at the last of the application program, and by reading the data in that address by the boot program and determining whether it is 00h. Here, h of 00h denotes the hexadecimal number (in hexadecimal notation), and 00h (hexadecimal notation) indicates 0 (decimal notation) in which all 8 bits (1 byte) are 0 (column 1, lines 51-60). Thus, it is also adapted to be utilized as a flag to indicate the status of storage portion.

**6. *Related Prior Art***

The following list of prior art is considered to be pertinent to applicant's invention, but not relied upon for claim analysis conducted above.

- Kennedy et al., (U.S. 6,084,968), "Security Token and Method for Wireless Applications."
- Brinkmeyer et al., (U.S. 5,708,712), "Vehicle Security Device with Electronic Use Authentication Coding."
- Alajajian, (U.S. 5,668,880), "Inter-Vehicle Personal Data Communications Device."
- Ogasawara et al., (U.S. 5,097,115), "Transaction Authentication System."
- Fiedler et al., (U.S. 5,995,624), "Bilateral Authentication and Information Encryption Token System and Method."



- Zeidler, (U.S. 4,578,530), "End-To-End Encryption System and Method of Operation."
- Wirstorm et al., (U.S. 4,694,492), "Computer Communications Security Control System."

### ***Conclusion***

7. Claims 1-4 and 6-20 are rejected as explained above.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

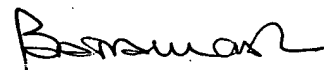
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheng-Jen Tsai whose telephone number is 571-272-4244. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on 571-272-4182. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sheng-Jen Tsai  
Examiner  
Art Unit 2186

June 21, 2005

  
**PIERRE BATAILLE**  
**PRIMARY EXAMINER**  
6/22/05